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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/652,838	08/30/2000	Christer Fahraeus	62994	4391

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EXAMINER

NGUYEN, CHANH DUY

ART UNIT PAPER NUMBER

2675

DATE MAILED: 10/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/652,838	FAHRAEUS ET AL	
	<b>Examiner</b>	<b>Art Unit</b>	
	Chanh Nguyen	2675	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 August 2000.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                    | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                           | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4,7-8</u> | 6) <input type="checkbox"/> Other:  |

## **DETAILED ACTION**

### ***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Information Disclosure Statement***

2. The references listed on the Information Disclosure Statement filed on February 27, 2001, January 16, 2002 and March 29, 2002 have been considered by examiner; see attached PTO-1449s.

### ***Drawings***

3. The drawings are objected to because of the foreign language used in Figures 1 and 9b. The English character must be used so that the drawings can be understood; see MPEP 608.02, Drawing Standard (p), Numbers, letters and reference letter. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Specification***

4. .The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

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5. The abstract of the disclosure is objected to because it is not a single paragraph.

Correction is required. See MPEP § 608.01(b).

6. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

### ***Claim Objections***

7. Claims 12-19, 27-31, 33-38 and 41 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only, and cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims 12-19, 27-31, 33-38 and 41 have not been further treated on the merits.

### ***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-11, 20-26, 32, 39-40, 42-46 are rejected under 35 U.S.C. 102(b) as being anticipated by Norwood (U.S. Patent No. 5,063,600)

As to claim 46, Norwood discloses a handheld electronic device (a size of a tablet paper (see column 3, lines 26-29) which is adapted to carry out predetermined operations (e.g., send electronic mail to another user; see column 23, lines 39-47) at

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the command of a user (selects the Bosses' icon), characterized by a sensor for detecting at last one activation icon (i.e. the pen combination with the tablet's surface can sense the location of the pen tip on the tablet to activate the Bosses' icon; see column 9, lines 59-68 and column 23, lines 39-47), and a signal processor which is adapted to carry out, in response to the sensor's detection of the activation icon, one of the predetermined operations (i.e. upon selecting the Bosses' icon, a handwritten note mails transmits to the boss computer).

While Norwood's device may be unlike applicant's discloses device, it reads on broad claimed language.

As to claim 45, this claim differs from claim 46 only in that claim 46 is apparatus whereas claim 45 is method. Thus, method claim 45 is analyzed as previously discussed with respect to apparatus claim 46 above.

As to claim 39, Norwood discloses a computer program for information management, which is stored in a computer-readable storage medium including instruction for causing the computer to detect an activation icon and initiate (i.e. the pen combination with the tablet's surface can sense the location of the pen tip on the tablet to activate the Bosses' icon; see column 9, lines 59-68 and column 23, lines 39-47), in response to the detection of the activation icon, a predetermined operation which utilizes electronic recorded , handwritten information (i.e. upon selecting the Bosses' icon, a handwritten note mails transmits to the boss computer).

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As to claim 43, this claim differs from claim 39 only in that claim 39 is method whereas claim 43 is apparatus. Thus, method claim 43 is analyzed as previously discussed with respect to method claim 39.

As to claim 20, this claim is also so broad that it read on the device of Norwood which can perform the hand-written mail operation upon the selection of the Bosses' icon as previously analyzed with respect to claims 39, 43, 45-46 above.

As to claim 1, this claim differs from claims 20, 43, 45-46 above only in that the limitation position code is additionally recited. This limitation reads on coordinate positions on the tablet as taught by Norwood (see column 9, lines 61-68).

As to dependent claims 2-11, 21-26, 32, 40, 42, 44, the limitations recited on the dependent claims are met by Norwood. For example, Norwood teaches icon (e.g., Bosses' icon) provide with position code (coordinate) as recited in claim 2. The tablet (22) of Norwood has number of coordinate positions which reads on the claimed "position code extends continuously over the writing surface as recited in claim 3. The claimed "discontinuous with the position code on at least one activation icon" recited in claim 4 reads on a number of separate coordinates located on the icon as taught by Norwood.

### ***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claims 1-11, 20-26, 32, 39-40 and 42-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okamoto (U.S. Patent No. 6,252,948) in view of Ishida (U.S. Patent No. 6,195,570).

As to independent claims 1, 20, 39, 43, and 45-56, Okamoto discloses a product having a writing surface as recited in claims 1, 20, 39, 43 and 45-46 with exception the limitation "icon". It is noted that Okamoto uses a button "transmit" to perform the same function as "icon" recited in the claim. For example, Okamoto teaches that a user can write a person name on the tablet (e.g., Nakamura; see Figure 6), and activate the button "transmit" to perform the operation of dialing for the recorded information (i.e. Nakamura). The only thing different from claims 1, 20, 39, 43, 45-46 and the reference of Okamoto is that claims recite the term "icon". It is well-known in the art to use an icon for enhancing the visibility of a user's eye. For example, Ishida uses an icon with telephone handle separate from the base (start button shown in Figure 3) to illustrate the function of transmission. Therefore, it would have been obvious to one of ordinary

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skill in the art at the invention was made to have substituted a well-known icons as taught by Ishida to the button of Okamoto so that an operator can see easily see or recognize the information to be activated without reading.

As to dependent claims 2-11, 21-26, 32 , 40, 42, 44, these claims are met by Okamoto and Ishida, and analyzed similar to the reference of Norwood as previously discussed above.

### **Inquiries**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chanh Nguyen whose telephone number is (703) 308-6603.

If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, Steven Saras can be reached at 305-9720.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

**(703) 872-9314 (for Technology Center 2600 only)**

Hand-delivered responses should be brought to Crystal Park II, 2121  
Crystal Drive, Arlington, VA, Sixth Floor (Receptionist)



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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

*C.N.*  
C.Nguyen  
September 27, 2002

*Chanh Nguyen*  
**CHANH NGUYEN**  
**PRIMARY EXAMINER**